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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,100	01/20/2004	Shigeru Tago	HIRA.0135	6941

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EXAMINER

VY, HUNG T

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/759,100	Applicant(s) TAGO, SHIGERU	
	Examiner Hung T. Vy	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the preliminary amendment filed 5/11/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/2004&1/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION Acknowledges

1. Receipt is acknowledged of the following items from the Applicant.

Information Disclosure Statement (IDS) filed on 08/20/2004 and 1/20/2004. The references cited on the PTOL 1449 form have been considered.

Specification

2. The specification has been checked to the extent necessary to determine the presence of possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: entering of the search key. Further the applicant should also include the step reciting of where or how to enter the search key. The drawing only shows the figured representing the database and "OK" button, but there is no box for entering the key word.

With respect to claim 2 and 6, the phrase "entering a next search key", "the search path candidates" render the claims indefinite since it is not clear who is entering the next search key. Is that the system enters the next search key for itself or some one have to enter the next search key. It is not clear what are the path candidates.

With respect to claims 2, and 6, "the search path candidates" have no antecedent basic.

Regarding claim 1, the phrase "can be" renders the claim(s) indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Claims 2-4 and 7-19 depend from rejected claims 1 and 6 thereby render these dependent claims indefinite

Claim Rejections - 35 USC 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-4 and 6-19 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

Art Unit: 2163

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

<http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the "practical application, result, concrete, useful and tangible"

limitations are not claimed in Applicant's claims, Examiner believes that the above listed claims are nonstatutory.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (see table below) of copending Application No. 10/8058376.

Present invention claims	Copending application
Claim 1,6	1

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in present application are similar to claims in co-pending application as shown.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-19 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Minch et al. (U.S. Patent. No. 2004/0049510).

With respect to claim 1, as best understood, Minch et al. discloses a method of designating a database search path and a program for causing a computer to carry out a method of designating a database search path comprising steps of: the method comprising: a first step of displaying databases that can be search targets (see fig. 2 or fig. 4), in the form of figures on a screen; a second step of designating individual figures and designating the databases corresponding to the designated figures as the first database and the terminal database (See paragraph 0008 or 0033, 0058); and a third step of carrying out a chain-reactive retrieval of search keys and records (see paragraph 0009) by following two steps, one of said two steps (see paragraph 0058) comprising retrieving records by using a search key that is entered into a database and another of said two steps comprising entering a next search key contained in said retrieved records into next database through the search path candidates (see paragraph 0095 and fig. 1-4).

With respect to claims 2 and 7, Minch et al. discloses the third step includes the step of displaying the search path candidates in the form of figures by with the figures indicating the individual database are connected (see fig. 0104).

With respect to claims 3-4, and 8-9, Minch et al. discloses the third step includes the step of narrowing the search path candidates down to only those that pass through all of the databases corresponding to designated figures other than the first database and terminal database (see fig. 4).

With respect to claims 10, 13-16, and 19, Minch et al. discloses either one or both of the following steps: displaying, upon designation of the first database, only those figures corresponding to databases that can be designated as the first database, on the screen, preferably with a feature distinguishing them from other figures (see fig. 4); and displaying, upon designation of the terminal database, only those figures corresponding to databases that can be designated as the terminal database, on the screen, preferably with a feature distinguishing them from other figures (see paragraph 0104).

With respect to claims 11-12, and 17-18, Minch et al. discloses the step of narrowing the search path candidates to only those that do not pass through any of the databases corresponding to designated figures other than the first database and terminal database (see fig. 4).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TIM VO
PRIMARY EXAMINER

Hung T. Vy
Art Unit 2163
June 24, 2006.